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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

06502.0367

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on _____

Signature _____

Typed or printed name _____

Application Number

10/035,579

Filed

12/28/2001

First Named Inventor

Guy L. Steele, Jr.

Art Unit

2193

Examiner

Chuong D Ngo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 56,249☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Nathan A. Sloan

Typed or printed name

202. 408. 4312

Telephone number

9/30/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193
PATENT
Customer No. 22,852
Attorney Docket No. 06502.0367-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Guy L. STEELE, Jr.)	Group Art Unit: 2193
)	
Application No.: 10/035,579)	Examiner: Ngo, Chuong D.
)	
Filed: December 28, 2001)	Confirmation No.: 2901
)	
For: FLOATING POINT SQUARE ROOT)	
PROVIDER WITH EMBEDDED)	
STATUS INFORMATION)	

Mail Stop AF
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Action mailed on May 25, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed August 23, 2005, which states "Applicant's arguments are not persuasive." (Advisory Action at p. 2).

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-37 remain pending, with claims 1-37 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,009,511 to Lynch et al. ("*Lynch*").

I. The rejection of claims 1-37 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch* is improper.

The Examiner's rejections contain clear errors and omit essential elements necessary to establish a *prima facie* case of obviousness of Applicant's claims 1-37 based on *Lynch*. *Lynch* does not teach or suggest

an analyzer circuit ... to determine a ... status of [an] ... operand based upon data within the ... operand; and
a results circuit ... configured to assert ... a resulting status embedded within the resulting floating point operand

(emphasis added) as recited by claim 1.

The rejection does not make clear what portion(s) of *Lynch* allegedly teaches the claimed "status." However, even assuming that *Lynch*'s tag value constitutes "status," (which Applicant does not concede) the tag value of *Lynch* is not "embedded within the resulting ... operand," as recited by claim 1.

The Examiner appears to assert that *Lynch*'s element 84 (Fig. 4) constitutes an "operand" which contains tag field 89 (alleged status). See Office Action mailed May 25, 2005 at p. 2. This is incorrect. *Lynch* specifically states that element 84 is a register stack, not an operand, and that register stack 84 contains a separate Reg Field 87 for storing an operand and a separate Tag Field 89 for storing a tag (alleged status). See *RFR* at pp. 3-4. Fig. 4 of *Lynch* clearly illustrates that Tag Field 89 (alleged status) and

Reg Field 87 (operand) are separate from each other and stored within register stack 84. This does not constitute a teaching or suggestion of “a resulting status embedded within the resulting ... operand,” as recited by independent claims 1, 14, and 26 and required by dependent claims 2-13, 15-25, and 27-37. Because *Lynch* does not teach each and every element recited in the claims, no *prima facie* case of obviousness has been established.

Moreover, the Examiner has not provided the required motivation to modify *Lynch* to achieve the claimed combination (see *RFR* at p. 5; see Office Action mailed May 25, 2005 at p. 2, 3). The Examiner asserts “although *Lynch et al.* does not explicitly disclose a ‘resulting status embedded within the ... operand,’ the teachings of an associated tag field for each operand in the register stack that stores operand results, and a tag generation for each result would make it obvious to ... store ... both the result with its associated tag ... in a register field (78) and its associated tag field (89) of the register stack (84).” Office Action mailed May 25, 2005 at p. 3. However, this motivation, even if proper (which Applicant does not concede) is directed to storing “both the result with its associated tag ... in ... the register stack.” This does not constitute motivation to provide “a resulting status embedded within the resulting ... operand,” as recited in the claims. Therefore, no *prima facie* case of obviousness has been established for claims 1, 14, and 26.

Accordingly, the rejection of claims 1-37 under 35 U.S.C. § 103(a) based on *Lynch* is improper. Applicant requests the board of examiners to allow these claims.

In view of the foregoing, claims 1-37 are in condition for allowance. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: Nathan A. Sloan
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